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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,748	01/18/2001	Jonathan E. Lowthert	INTL-0511-US (P10480)	7988

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EXAMINER

DEMICO, MATTHEW R

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 08/04/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/764,748

Applicant(s)

LOWTHERT ET AL.

Examiner

Matthew R Demicco

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 56. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Figure 7, 76a. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because in Figure 3, reference number 74 is used to depict both a bus and a BIOS. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 2611

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 9-11, 19-22 and 28-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-11, 18-19, 21-22 and 9-10 of copending Application No. 09/765,246. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations.

Claim 1 of the instant application corresponds to Claim 1 of the '246 application.

Claim 1 differs in that it identifies content and advertising used on the receiver and collects information to enable a credit to content providers for inserted advertising. This is an obvious variation because collecting information and crediting content providers is well known in the art as disclosed by U.S. Patent No. 5,724,521 to Dedrick. Such a modification is desirable in order to increase revenue from advertisers by tracking an ad's airtime and billing accordingly.

Claims 9-10 of the instant application correspond to Claims 9-10 of the '246 application.

Claim 11 of the instant application corresponds to Claim 11 of the '246 application. Claim 11 differs in the same manner as Claim 1 above.

Claims 19-20 of the instant application correspond to Claims 18-19 of the '246 application.

Claim 21 of the instant application corresponds to Claim 21 of the '246 application. Claim 21 differs in the same manner as Claim 1 above.

Claim 22 of the instant application corresponds to Claim 22 of the '246 application.

Claims 28-29 of the instant application correspond to Claims 9-10 of the '246 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond et al. in view of U.S. Patent No. 5,724,521 to Dedrick.

Regarding Claim 1, Zigmond discloses a method comprising allowing the use of content on a content receiver (See Figure 5 and Col. 4, Lines 16-24), automatically interrupting the use of the content (Col. 7, Lines 26-29) and enabling the receiver to

temporarily replace the content with advertising (Col. 7, Lines 30-36 and Col. 4, Lines 45-52). Zigmond further discloses identifying content used on the receiver (Col. 9, Lines 21-45). What is not disclosed, however, is identifying advertising inserted by the receiver and collecting information to enable a credit to content providers for inserting advertising. Dedrick discloses a method for providing electronic advertisements to users using profiles (See Abstract). Dedrick further discloses monitoring what information is viewed and storing it in a database (Col. 8, Lines 17-27) including what advertisements were watched and for how long (Col. 9, Lines 28-48). Dedrick also discloses charging the advertisers a fee each time the advertisement is consumed by a user (Col. 11, Lines 16-21 and Col. 12, Lines 5-8) and crediting a publisher if, for instance, the ad is associated with the publisher's content (Col. 15, Lines 37-46). This reads on the claimed identifying advertising inserted by the receiver and collecting information to enable a credit to content providers (publishers) for inserting advertising. Dedrick is evidence that ordinary workers in the art would recognize the benefits of monitoring which ads were consumed and charging based on the consumption in a targeting advertising system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Zigmond with the monitoring and charging of Dedrick in order to increase revenue from advertisers by tracking an ad's airtime and billing accordingly.

Regarding Claim 2, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses that ads may be selected for playback during the presentation a particular program (Col. 12, Lines 44-56). This reads on the claimed

Art Unit: 2611

identifying content and advertising based on a time relationship between the content and the advertising.

Regarding Claim 3, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses displaying an ad in relation to the subject matter of the programming (Cols. 12-13, Lines 60-6). After a particular star of a movie appears on a show, an ad for a movie featuring that star may be displayed. This reads on the claimed identifying content and advertising based on the order of playing the advertising and content.

Regarding Claim 4, Zigmond in view of Dedrick disclose a method as stated above in Claim 3. Zigmond further discloses monitoring the times of day programming is watched and the amount of time spent watching (Col. 11, Lines 14-19). This reads on the claimed collecting information about the amount of content selected for play on the receiver.

Regarding Claim 5, Zigmond in view of Dedrick disclose a method as stated above in Claim 4. Zigmond further discloses providing information to a remote processor-based system (Col. 9, Lines 45-55 and Col. 4, Lines 55-67). This information includes the actions of the user before, during and after the ad, channel changes, requests for additional information, and feedback in response to an ad. This reads on the claimed reporting to a remote processor-based system information about what content was played with advertising.

Regarding Claim 6, Zigmond in view of Dedrick disclose a method as stated above in Claim 5. Zigmond further discloses selecting advertising based in part on the content being played on the receiver (Col. 12, Lines 44-62).

Regarding Claim 7, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses that the receiver is operable to receive television programming in addition to pay-per-view programming and other forms of video content (Col. 6, Lines 13-29). In such a television system, the user is able to choose programming they wish to watch (Col. 11, Lines 16-18). This reads on the claimed receiving a user content selection. Further disclosed is identifying advertising to associate with the content (Col. 11, Lines 31-49).

Regarding Claim 8, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses identifying the content television programming (Col. 11, Lines 8-13 and Col. 12, Lines 60-63) for selecting an advertisement. This reads on the claimed determining a type of the content.

Regarding Claim 9, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses that predetermined times (Cols. 2-3, Lines 67-1) are specified in the video feed for insertion of advertising (Col. 7, Lines 26-29). This reads on the claimed including automatically replacing the content with advertising after allowing content to be used for a predetermined amount of time.

Regarding Claim 10, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses automatically determining at predetermined times whether to replace the content (Col. 7, Lines 26-29).



Art Unit: 2611

Regarding Claim 11, see Claims 1 and 5 above. Further, Zigmond discloses a system including computer-readable media having computer-executable instructions stored thereon (Col. 6, Lines 48-55). It is inherent that such a computer-based device has a processor in order to execute the stored instructions.

Regarding Claim 12, see Claim 2 above.

Regarding Claim 13, Zigmond in view of Dedrick disclose an article as stated above in Claim 12. Dedrick further discloses charging the advertiser a fee each time an advertisement is consumed (Col. 11, Lines 16-21) and periodically generating a bill to send to the advertisers (Col. 15, Lines 21-25). Dedrick also discloses charging the advertisers a fee each time the advertisement is consumed by a user (Col. 11, Lines 16-21 and Col. 12, Lines 5-8) and crediting a publisher if, for instance, the ad is associated with the publisher's content (Col. 15, Lines 37-46). This reads on the claimed enabling the receiver to accrue a credit to the provider of content (publisher) that is proximate to the advertisement.

Regarding Claim 14, Zigmond in view of Dedrick disclose an article as stated above in Claim 13. As stated above, a fee is charged to the advertiser for each time the advertisement is consumed by an individual end user (Col. 11, Lines 16-21). Dedrick also discloses charging the advertisers a fee each time the advertisement is consumed by a user (Col. 11, Lines 16-21 and Col. 12, Lines 5-8) and crediting a publisher if, for instance, the ad is associated with the publisher's content (Col. 15, Lines 37-46). This reads on the claimed enabling the receiver to accrue a credit to the content provider (publisher) based on the amount of content selected for play on the receiver.

Regarding Claims 15-17, see Claims 5-7 above, respectively.

Regarding Claim 18, Zigmond in view of Dedrick disclose an article as stated above in Claim 11. Zigmond further discloses a system wherein the receiver is operable to receive television programming in addition to pay-per-view programming and other forms of video content (Col. 6, Lines 13-29). In such a television system, the user is able to choose programming they wish to watch (Col. 11, Lines 16-18). This reads on the claimed enabling a variety of content to be selected for play at any time.

Regarding Claims 19 and 20, see Claims 9 and 10 above, respectively.

Regarding Claim 21, Zigmond discloses a system comprising a receiver (Col. 6, Lines 48-67) that receives the transmission of content (Col. 7, Lines 1-25). Further disclosed is the ability of the receiver to enable the use of content to be interrupted and temporarily replaced with advertising as stated above. This reads on the claimed "shell". Also disclosed is storage coupled to the receiver storing instructions (Col. 6, Lines 50-61) that enable the receiver to associate advertising with content as stated above. Zigmond in view of Dedrick discloses a receiver enabled to credit a content provider for inserted advertising as stated above.

Regarding Claim 22, Zigmond discloses a system as stated above in Claim 21, wherein the system is a television receiver (Col. 6, Lines 40-44).

Regarding Claims 23-25, see Claims 12-14 above, respectively.

Regarding Claim 26, see Claim 5 above.

Regarding Claim 27, see Claim 7 above.

Regarding Claims 28 and 29, see Claims 9 and 10 above, respectively.

Regarding Claim 30, see Claim 18 above.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. 5,774,170 to Hite et al. discloses a television-based targeted advertising system with program identification, commercial ordering and time-stamping of viewed commercials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mrd  
July 19, 2004



VIVEK SRIVASTAVA  
PRIMARY EXAMINER